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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,119	09/22/2003	James D. Kelly	18602-08098 (P2080R1C1)	8760
61520	7590	11/20/2007	EXAMINER	
APPLE/FENWICK SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			RAY, GOPAL C	
			ART UNIT	PAPER NUMBER
			2111	
			MAIL DATE	DELIVERY MODE
			11/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/669,119

Applicant(s)

KELLY ET AL.

Examiner

Gopal C. Ray

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

1. Claims 18 and 19 are presented for examination.
2. The amendments to the abstract and claims 18-19 filed on 11/1/07 are proper.
3. Claims 18 and 19 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. Furthermore, claims 18 and 19 are rejected under 35 U.S.C. 251 because these are broadened claims but filed after 2 years of original patent issued which is improper.
4. Applicant's request for reconsideration with remarks supported by evidence of the rejection of claims 18 and 19 in the last Office action based upon a defective reissue declaration and broadened claims filed after 2 years under 35 U.S.C. 251 is not persuasive and, therefore, the rejection of the claims under 35 U.S.C. 251 still holds.

Applicants' position is that as long as they filed the first broadening reissue application within the two year period allowed by statute, then they may continue to file broadening reissue applications for as long as they like as long as copendency is maintained. They maintain this position even when the circumstances leading to the need to file broadening reissues are unrelated to each other. Thus, according to applicant, if a patentee is "lucky" enough to have cause to file a broadening reissue within two years of the original patent, he/she is essentially given a free license to broaden the claims further and in entirely different or unrelated ways during the entire term of the patent as long as the patentee maintains a perpetual and continuing chain of reissue applications. This is contrary to the strong public policy intended to be enforced by the last paragraph of 35 U.S.C. § 251.

Applicants cannot have it both ways. If they desire the earlier filing date of the first reissue application, available under 35 U.S.C. §120 and 37 CFR §1.60, they cannot seek reissue of reissue patent RE 38,428. On the other hand, if they desire to reissue patent RE 38,428, they cannot claim the earlier filing date of the first reissue application under the continuation practice of 35 U.S.C. § 120 and 37 CFR §1.60. In this case, this second reissue application was one thing, i.e., seeking reissue of the original patent, and then it was another, i.e., seeking reissue of the reissue patent RE 38,428. But as to the former, the errors sought to be corrected had already been corrected in the first reissue application and, therefore, there was no basis for another reissue application. As to the latter, the applicants are not entitled to the benefit of the first reissue application's filing date and, therefore, the second reissue application does not comply with the two year requirement for filing broadening reissues.

First, the examiner maintains that the Commissioner does not issue a second broadened reissue patent on an invention which

is not distinct and separate from the invention which was corrected by reissue patent RE38,428. Second, the examiner maintains that there is no error without deceptive intent within the meaning of the statute because applicants took no steps to correct the defect before the issuance of reissue patent RE38,428.

In conclusion, the present reissue application does not comply with 35 U.S.C. 5 251 because 1) it seeks to broaden claims of original patent 5,996,036 and of reissue patent RE38,428 more than two years after the date of the original patent; 2) the patent for which reissue is sought (reissue patent RE38,428) had not been granted when this reissue application was filed; and 3) appellants' failure to try and stop the grant of the defective reissue patent RE38,428 is factual evidence that there was no "error without any deceptive intention" in granting of reissue patent RE38,428.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (571) 272-3631. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (571) 272-3632. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [\[mark.rinehart@uspto.gov\]](mailto:mark.rinehart@uspto.gov).

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

If applicant wants to discuss something with the examiner relating to the examination of this application, he/she should file a request to the USPTO on an

Application/Control Number:  
10/669,119  
Art Unit: 2111

Page 6

Applicant Initiated Interview Form, PTOL-413A stating type of interview requested, proposed time, date of interview and issues to be discussed as required by the office. See MPEP 713.01. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC central telephone number is (571) 272-2100.

Moreover, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lastly, paper copies of cited U.S. Patents and Patent Application Publications ceased to be mailed to applicants with office actions as of June 2004. Paper copies of Foreign Patents and Non-Patent Literature will continue to be included with office actions. These cited U.S. Patents and Patent Application Publications are available for download via Office's PAIR. As an alternate source, all U.S. Patents and Patent Application Publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. Patent or Patent Application Publications will not be granted.

*Gopal C. Ray*  
GOPAL C. RAY  
PRIMARY EXAMINER  
GROUP 2100